

REMARKS

I. Status of Claims

Upon entry of the instant amendment, claims 11 and 47-60 will be pending. Claims 1, 19-21, and 36-46 have been canceled without prejudice. Applicants reserve the right to pursue the subject matter of all canceled claims in one or more continuation applications. Claims 11, 47, 52, and 56 have been amended. Support for the claim amendments can be found throughout the application as filed, for example, at page 3, [010]; page 22, [072]; page 24, [077]; and page 26, [083]. Claims 59 and 60 have been newly added. Support for the new claims can be found throughout the application as filed, for example, at page 5, [014]; and page 27, [085]. No new matter has been added.

II. Rejections Under 35 U.S.C. § 112, First Paragraph, Enablement

Claims 1, 19-21, 38, and 42 were rejected under 35 U.S.C. § 112, first paragraph, because the Action alleges that the specification, while being enabling for a lubricin such as the polypeptide of SEQ ID NO:7, does not reasonably provide enablement for the polypeptide fragment of SEQ ID NO:9 (*see*, Office Action, pages 2- 5). Without acquiescing to this rejection and solely to expedite prosecution, applicants have canceled claims 1, 19-21, 38, and 42 without prejudice, thereby obviating the present rejection. Accordingly, applicants request that the present rejection be withdrawn.

III. Rejections Under 35 U.S.C. § 112, Second Paragraph:

Claims 1, 11, 19, 47, 48, and 52 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite (*see*, Office Action, pages 5-6). Applicants do not agree that any of these claims are indefinite. However, in the interest of expediting prosecution, applicants have amended the claims as described below.

Claims 19 and 47 were rejected for reciting, in relevant part, that “the protein is O-linked with β -(1-3)-Gal-GalNac.” Claim 19 has been canceled, thereby obviating the rejection with

respect to that claim. Applicants have amended claim 47 to recite in relevant part, that “the protein is O-linked to β -(1-3)-Gal-GalNac.”

Claim 52 was rejected because the Action states that the word “matrix” as well as the placement of the matrix relative to the polypeptide are indefinite. Claim 52 has been amended as suggested by the Office to recite in relevant part, “wherein the composition is encapsulated in an implantable drug delivery matrix.”

Claim 11 was rejected for reciting: “An isolated protein comprising SEQ ID NO:7.” As suggested by the Office, applicants have amended claim 11 to recite: “An isolated protein comprising the polypeptide of SEQ ID NO: 7.”

Accordingly, applicants request that all rejections under 35 U.S.C. § 112, second paragraph, be reconsidered and withdrawn.

IV. Allowable Subject Matter:

The Office has indicated that SEQ ID NO:7 is not disclosed by the prior art and that claims 11, 47, and 52 would be allowable if rewritten to overcome the 35 U.S.C. § 112, second paragraph, rejections and if claim 11 is amended to delete non-elected subject matter (*see*, Office Action, page7). In view of the instant amendments, applicants submit that all pending claims are in condition for allowance, which action is respectfully requested.

V. Information Disclosure Statement:

Applicants submit herewith an Information Disclosure Statement (IDS) and respectfully request that the Office consider the cited references and return an initialed copy of the IDS with the next Official Communication.

Applicant : Carl Ralph Flannery *et al.*
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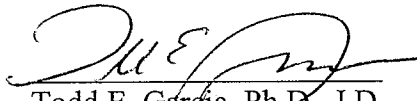
CONCLUSION

Applicants respectfully request that all rejections be withdrawn and that all claims be allowed. A Petition for Extension of Time for a one-month extension is being filed herewith, along with the fee of \$130. Please apply this charge and any deficiencies to Deposit Account 06-1050, referencing Attorney Docket No. 19003-0002US1.

Respectfully submitted,

Date: _____

2/12/09


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